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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. .....

THE GALION METALLIC VAULT COMPANY,
Petitioner,

v.

EDWARD G. BUDD MANUFACTURING COMPANY,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Court of Appeals
For the Third Circuit.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, the Galion Metallic Vault Company, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Third Circuit to review the decree of that Court holding invalid the claim in suit[1] of United States Letters Patent No. 1,603,095

[1] Claim 1 of Patent No. 1,603,095 reads:

"1. In an automobile truck, the combination with a chassis frame, a load-carrying platform, means for supporting said platform above and in spaced relation to the chassis frame including a pair of longitudinal supporting members adapted to be mounted upon the chassis frame, and means forming a compartment beneath said platform for receiving pneumatic tires, said longitudinal members being cut away at their forward ends to receive the lower portion of said compartment."

to Herman D. Palmer, which decree was entered on June 30, 1948.[2] (PR. 144, 151.)

SUMMARY STATEMENT OF THE MATTER INVOLVED.

There are two basic issues in this case:

First, whether, when an invention (and the patent covering it) is admittedly new and useful and falls within the patentable classification of the statute, it can be defeated by a new doctrine originated by the Circuit Court of Appeals below that it must be "patentably new"; and

Second, whether there is misuse of a patent when the patentee has a claim in which his truck body is properly claimed but the truck to which it is attached is referred to in the claim in order to point to the subject matter to which the invention applies; and the patentee sells and licenses the claimed subject matter except the truck.

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[2] The opinion of the District Court is reported at 74 USPQ 90 and is set out at pages 3a to 9a of Petitioner's Record. The Final Judgment of the District Court is set out at page 10a of Petitioner's Record.

The opinion of the Circuit Court of Appeals for the Third Circuit is reported at 78 USPQ 135 and is included in the Record transmitted with this Petition. (PR. 144.) The judgment of the Circuit Court of Appeals for the Third Circuit was entered on June 30, 1948, and is included in the Record transmitted with this Petition. (PR. 151.)

The Record transmitted with this Petition is the partial record designated by the parties in, and considered by, the Circuit Court of Appeals for the Third Circuit, printed in appendices to the briefs of Petitioner (Plaintiff-Appellant below) and Respondent (Defendant-Appellee below).

References to the Record are:

PR .....—Petitioner's (Plaintiff-Appellant below) Record and Opinion and Judgment of the Circuit Court of Appeals for the Third Circuit.

RR .....—Respondent's (Defendant-Appellee below) Record.

In this case the claim covered a truck body of a particular type which contained the invention, and in order to point out to what the construction was to be applied a truck was referred to in the claim as background. The patentee licensed the United States Government without cost to it at its request, and offered to license the Respondent and other competitors. The Courts below held that this was misuse in trying to sell and license under a patent the truck body but not the truck. Petitioner and Respondent were manufacturing bodies and not trucks.

If this extraordinary holding be law, we estimate more than forty per cent. of all patents now issued which are so drawn will be invalid.

We believe there is conflict of opinion below, not in result, but on the issue of whether the invention was new, the Court of Appeals saying "The District Court found Palmer's 'suggestion that a spare tire be carried at the place which it indicates is new' • • • but to achieve patentability it must 'not only be new but, we think, *patentably new* in view of the art.'" 78 USPQ 135, 136, 137. (PR. 146, 147.)

NATURE OF THE SUBJECT MATTER.

The single claim of Patent No. 1,603,095 deals with a body for a truck where the spare tire can be placed in a protected position beneath the truck body without undue elevation of the truck body, where it is readily accessible, and where it will not shorten the length of the body.

Respondent's expert when asked whether he found anything in the prior art suggesting this idea of carrying a tire in such a position with respect to a truck body said: "If you limit it to a tire, the answer is no." (PR. 137a.) The District Court likewise said: "It might be added that, if the mere idea of carrying the spare in a particular place could give validity to the Palmer patent, it would probably be

entitled to a broad construction, because, concededly, the suggestion that a spare tire be carried at the place which it indicates is new." (PR. 6a.) The Respondent does not claim, nor could the Circuit Court of Appeals or the District Court find, any instance of carrying a tire in such a position.

Many millions of dollars of truck bodies have been sold embodying this invention and that is why the Government sought a license which was freely given for nothing by this Petitioner, the result being that substantially every United States Army truck embodied this invention throughout World War II, where the tire problem arose with bodies of this type.

The only prior public uses and prior art—of the same type considered by the Patent Office—were those in which small boxes for carrying tools, oxygen tanks, etc., had been placed beneath the truck body but in no case was the construction the same and in no case was the tire carried in such a position even though it was a very pressing problem on every one of the prior art trucks.

Patents are only of use and only justify themselves when they are of practical application in the encouragement and protection of manufacturing and selling. In this trade the particular situation is this: One group of manufacturers, like the Petitioner and Respondent, manufacture bodies for trucks; another group of manufacturers, such as the automobile companies, manufacture the trucks to which the bodies are supplied either to the automobile manufacturer or to the dealer who combines them with the trucks for sale to the user.

In the claim, under the law as it has existed from the beginning of the patent system, the patentee stated that his invention was applied in combination with a truck frame; and after these orientation words, proceeded to define the invention of the body in accurate terms as to which accuracy there is no controversy. This claim is

in accordance with the practice approved by this Court so recently as in the case of *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364. It is characteristic of what we conservatively estimate to be more than forty per cent. of all patents issued in the mechanical arts. In view of the fundamental importance of this question we take the liberty of directing this problem to this Court's attention.

No charge under the misuse phase of this case has been made of any abuse of the patent system except that, because the claim followed the conventional pattern of mentioning the truck and a chassis to orient the usefulness of the claimed body combination, that this was an attempt to control less than the whole of the claim and therefore an attempt to control unpatented subject matter.

On the first issue, the art was such that Respondent's expert when asked whether he found anything in the prior art suggesting this idea of carrying a tire in such a position with respect to a truck body said: "If you limit it to a tire, the answer is no." (PR. 137a), and the District Court said: "* * * concededly, the suggestion that a spare tire be carried at the place which it indicates is new." (PR. 6a), but the Circuit Court of Appeals went further and introduced a new standard of invention not found in the patent statutes that it was not enough for an invention to be new, to be useful, and to fall in the category of subject matter that is patentable, but it must be "patentably new." 78 USPQ 135, 137. (PR. 146, 147.) This Court established a milestone as to invention in *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127, that three things must be present: novelty, utility, and the right classification, to make an invention patentable, but in this case a fourth requirement has been introduced by the Third Circuit Court of Appeals. If it is right, a large proportion of patents now existing will be invalidated.

We, therefore, take the liberty of filing this Petition because these two questions are of national importance and so fundamental that they should be decided at an early date to complete this Court's position on invention. There is no other defendant available in any other jurisdiction and the patent has expired.

DECISION OF THE DISTRICT COURT.

The District Court said (74 USPQ 90):

> "In general, the underlying idea, claimed to be invention, of the Palmer patent consists in providing a partially enclosed space or compartment near the front of an automobile truck, over the chassis and beneath the body floor, in which a spare tire may be carried in a horizontal position. The advantages of this arrangement are that it does not reduce the length of the load-carrying space of the truck, as where spare tires are mounted at the back of the cab in a vertical position, that it does not interfere with loading and unloading or with supplying gasoline to a rear tank, as where spare tires are on the rear end of the body, and that it does not interfere with the free use of the cab, as where tires are mounted on the running board." (PR. 3a.)

The Court further said: "I think that the tire carrying space of the accused structure infringes." (PR. 6a.) And on the subject of validity it said:

> "It might be added that, if the mere idea of carrying the spare in a particular place could give validity to the Palmer patent, it would probably be entitled to a broad construction, because, concededly, the suggestion that a spare tire be carried at the place which it indicates is new." (PR. 6a.)

This last statement referred to the admission of Respondent's expert to the single question propounded to him on cross examination as follows:

> "Q. Mr. McNulty, let's see if you and I can get together a little closer and simplify this thing and

reduce it down to an issue that might be helpful to the Court. Will you tell me, prior to the date of the Palmer application in July, 1923—of the Palmer patent—where you find any patent or publication or prior use has been proved here or agreed to that shows the combination of a tire carried near the front end of a truck body, beneath the bottom of the body, on top of the chassis frame and in front of the forward end of the body sill or a cut-away portion thereof?

"A. If you limit it to a tire, the answer is no." (PR. 136a, 137a.)

The District Court found, however, that while wide commercial success had attended this invention, the fact that a prior publication and a prior use, which showed a space too small for a tire and which was used for other materials, made the Palmer patent "invalid for want of invention." (PR. 5a.)

The District Court further held as to misuse, the Court saying:

"The Palmer claim begins 'In an automobile truck, the combination with a chassis frame' etc. The plaintiff's contention is that this claim was not intended to and does not cover the chassis frame but was only for a truck body, *per se*, and that the chassis frame as well as the truck was put in merely as background words of orientation in order to describe the environment in which the patented structure is useful.

"There have been cases, notably *Williams Manufacturing Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, in which claims for improvements have been construed not to include the older mechanism described in them. The point in the *Williams* case was not infringement but validity—whether an improvement patent which claims the old mechanism, as well as the improvement, covers so much ground that it amounts to an attempt to repatent machines which had become common property.

"However, looking at the opinion solely as a matter of interpretation, it is clear that a claim such as

Palmer's in which a major element of the old combination is an indispensable factor in the combination of the invention, was not the kind of claim Mr. Justice Roberts was talking about. Referring to the claim before him, he says, 'In mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination.'

"The 'compartment' element of Palmer's claim, construed broadly (as I think it should be and as it must be if it is to cover the space where the tire is carried in the defendant's body) has no bottom and, of course, it is necessary to have some element to support the tire in place. The patent is described as covering a 'tire carrier'; and a compartment with a top and sides but no bottom cannot possibly be a tire carrier. Thus the relationship between the patented elements of the compartment and the chassis frame is functional and goes directly to the essence of the patent. The chassis frame, specifically claimed, after reference to the entire vehicle, is plainly more than descriptive background." (PR. 7a, 8a.)

And in conclusion the Court held:

"So construed, the patents have been plainly misused by the plaintiff under the principles of the *Mercoid* case, 320 U. S. 661; the *Carbice* case, 283 U. S. 27 and in *Leitch Mfg. Co. v. Barber Co.*, 302 U. S. 458. The plaintiff is competing with body manufacturers. Purchasers from it of the bodies have, of course, an implied license to use them in the manufacture and sale of vehicles which embody the combination patented. It offers licenses on a royalty basis to other body manufacturers. Inasmuch as the bodies themselves are not patented this amounts to the practice condemned in the *Leitch* case, *supra.*" (PR. 8a.)

DECISION OF THE CIRCUIT COURT OF APPEALS.

The Circuit Court of Appeals could find no anticipation and conceded novelty, utility and patentable classification, but introduced a fourth factor of a thing being "patentably new" which apparently meant some new and undefined standard of invention which we do not find in the statute. The introduction of such factor imports into the statute a standard of invention never recognized by this Court, because while novelty, utility and determination of the class of the invention are proveable and determinable matters, the introduction of the standard **"patentably new" in view of the art opens a vast area of uncertainty, so that no manufacturer owning a patent would know where he stands.**

The Circuit Court of Appeals held on misuse, saying: "Appellant admits that it offers competing body manufacturers 'a license to use Plaintiff's patents in constructing their truck bodies.' Those truck bodies are not patented. The assertion that the Palmer claim was confined to the truck body is not tenable" (78 USPQ 135, 137; PR. 149), and further says:

> "Appellant's practice in connection with these patents is not excused, as is argued, by the decision in *Williams Mfg. Co. v. United Shoe Machinery Corporation*, 316 U. S. 364, which is not applicable to the circumstances before us. The controlling doctrine is that stated by Mr. Justice Brandeis for the Supreme Court in *Leitch Co. v. Barber Co.*, 302 U. S. 458, 463, where he said, '* * * every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process. It applies whatever the nature of the device by which the owner of the patent seeks to effect such unauthorized extension of the monopoly.' And see the *Mercoid* cases, 320 U. S. 661, 320 U. S. 680." (78 USPQ 135, 138; PR. 149, 150.)

JURISDICTION.

This is a suit arising under the Patent Laws of the United States, Judicial Code, § 24 (7); 28 U. S. C. A. § 41 (7). The jurisdiction of this Court is invoked under § 240(a) of the Judicial Code, as amended by the Act of February 13, 1925, 28 U. S. C. A. § 347. The date of the judgment which Petitioner seeks to have reviewed is June 30, 1948.

Cases believed to sustain the jurisdiction are:

LeRoy v. Tatham, 55 U. S. 156;

DeForest Radio Co. v. General Electric Co., 283 U. S. 664;

O'Reilly v. Morse, 15 How. 62;

The Telephone Cases, 126 U. S. 1;

American Fruit Growers v. Brogdex, 283 U. S. 1;

Schriber-Schroth v. Cleveland Trust, 305 U. S. 47; 304 U. S. 587;

Exhibit Supply Co. v. Ace Corp., 315 U. S. 126;

Muncie Gear Co. v. Outboard Motor Co., 315 U. S. 759;

Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U. S. 364;

Precision Instrument Mfg. Co. v. Automotive Mach. Co., 324 U. S. 806;

Lincoln Engineering v. Stewart-Warner, 303 U. S. 545;

Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1;[1]

Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U. S. 127.

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[1] In *Halliburton Oil Well Cementing Co. v. Walker,* 329 U. S. 1, notwithstanding the absence of conflicting decisions between different Circuit Courts of Appeals with respect to the patent there in suit, this Court granted a writ of certiorari to consider whether the statutory requirement (R. S. § 4888) of distinctness and certainty in claims was correctly applied by the lower court.

REASONS FOR THE ALLOWANCE OF THE WRIT.

Petitioner believes that writ of certiorari should be granted in this case for the following reasons, and accordingly the discretionary power of this Court is invoked.

I.

A PATENT IS VALID IF IT COVERS SUBJECT MATTER NOVEL, USEFUL, AND FALLING WITHIN ONE OF THE CATEGORIES OF PATENTABLE INVENTION SPECIFIED IN TERMS BY THE STATUTE. THERE IS NO REQUIREMENT THAT IT MUST BE "PATENTABLY NEW" BECAUSE THERE IS NO SUCH SPECIFICATION IN THE STATUTE.

The Circuit Court of Appeals for the Third Circuit has rendered a decision in conflict with the principles of this Court in *Loom Co. v. Higgins*, 105 U. S. 580; *Clough v. Barker*, 106 U. S. 166; *Topliff v. Topliff*, 145 U. S. 156; *Potts & Co. v. Creager*, 155 U. S. 597; *Mast, Foos & Co. v. Stover*, 177 U. S. 485; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428; *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U. S. 1; *Radio Corp. of America v. Radio Engineering Laboratories, Inc.*, 293 U. S. 1; *Smith v. Snow*, 294 U. S. 1; *Temco Co. v. Apco Co.*, 275 U. S. 319; *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U. S. 364; *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127.

A prior use which cannot be used for the same purpose, nor is intended for the same purpose, and without modification, cannot anticipate a patent and **the resort to a non-statutory defense that the patent must be "patentably new"** is contrary to what this Court has held as to a prior publication or a prior use. *Topliff v. Topliff*, 145 U. S. 156.

It has been the rule of this Court followed by the Circuit Courts of Appeals, best stated in *Clough v. Barker*, 106 U. S. 166, by Mr. Justice Blatchford, that where, as in this case the prior hawker's lorry disclosed in the Cooper

Vehicle Journal and the Ohio Mine Rescue Cars **were not for the purpose of carrying tires**, the Court said:

> "The structure was not designed for the same purpose as Clough's, no person looking at it or using it would understand that it was to be used in the way Clough's is used, and it is not shown to have been really used and operated in that way." (106 U. S. 166, 176.)

Hogg v. Emerson, 6 How. 437; *Loom Co. v. Higgins,* 105 U. S. 580; *Eames v. Andrews,* 122 U. S. 40; *Potts & Co. v. Creager,* 155 U. S. 597; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.,* 220 U. S. 428; *Symington Co. v. National Malleable Castings,* 250 U. S. 383; *Radio Corp. of America v. Radio Engineering Laboratories, Inc.,* 293 U. S. 1; *Goodyear Co. v. Ray-O-Vac Co.,* 321 U. S. 275; *Pyrene Mfg. Co. v. Boyce* (CCA 3), 292 Fed. 480; *Block v. Nathan Anklet Support Co.* (CCA 2), 9 F. (2d) 311; *Radio Corp. of America v. Twentieth Century Radio Corp.* (CCA 2), 19 F. (2d) 290; *Skelly Oil Co. v. Universal Oil Products Co.* (CCA 3), 31 F. (2d) 427; *Gordon Form Lathe Co. v. Walcott Mach. Co.* (CCA 6), 32 F. (2d) 55; *Artcraft Silk Hosiery Mills v. Gotham Silk Hosiery Co.* (CCA 3), 72 F. (2d) 47; *McMichael & Wildman Mfg. Co. v. Ruth* (CCA 3), 128 Fed. 706; *Trabon Engineering Corp. v. Dirkes* (CCA 6), 136 F. (2d) 24.

II.

MISUSE DOES NOT ARISE WHERE A PATENTEE OFFERS TO LICENSE AND DOES LICENSE THE GOVERNMENT AND COMPETITORS IN AN ENTIRELY PROPER MANNER JUST BECAUSE THE CLAIM STARTS IN ITS PREAMBLE WITH WORDS OF ORIENTATION SUCH AS "IN COMBINATION A TRUCK" ETC. THE STATUTE (R. S. 4888, 35 U. S. C. A. § 33) REQUIRES SUCH PARTICULAR SPECIFICATION. TO HOLD OTHERWISE IS IN CONFLICT WITH THE DECISIONS OF THIS COURT AND THE CIRCUIT COURTS OF APPEALS.

The essence of the decision in the Circuit Court of Appeals for the Third Circuit on this point is that just because the truck and its frame were mentioned in the claim, there was an attempt by the Petitioner to control an unpatented combination on the body covered by the claim. This ignores the decisions of this Court in *Temco Co. v. Apco Co.*, 275 U. S. 319; *Loom Co. v. Higgins*, 105 U. S. 580; *Deering v. Winona Harvester Works*, 155 U. S. 286.

In these cases, as in the case of *Temco Co. v. Apco Co.*, 275 U. S. 319, this Court affirmed the holding of the Sixth Circuit Court of Appeals in *K. W. Ignition Co. v. Temco Electric Motor Co.*, 283 Fed. 873, in which the claim commenced "in an automobile construction, the combination of a non-rotating axle for the ground wheels" and then continued with the specific invention applicable to the automobile. This Court therefore approved the remark of the Circuit Court of Appeals for the Sixth Circuit "But it is only in a highly technical sense that the patent can be regarded as upon an automobile." 283 Fed. 873, 880.

To the same effect was the decision of this Court in *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U. S. 364, 368, 369, where it was said:

> "We think, however, that each of the claims is confined to a combination of specified means applicable only to a restricted portion and function of the whole

machine. In stating his claims, the patentee sometimes says 'a machine of the class described having, in combination, * * *.' Obviously, no machine will infringe which does not have in combination the means specified in each of the claims for accomplishing the particular portion of the total operation covered by the claim. Other claims refer to 'a lasting mechanism of the class described having, in combination, * * *.' The same comment is applicable. **Other claims read: 'In a machine of the class described, the combination * * *.' Such preliminary statement is commonly and properly used to specify the type of machine in which the claimed subsidiary combination of elements works an improvement over the prior art.**[6] In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail,[7] but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. **To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines.** It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed, and equally

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[6] *Compare e.g. Grier v. Wilt,* 120 U. S. 412, 420, 421; *Morley Machine Co. v. Lancaster,* 129 U. S. 263, 266; *Keystone Manufacturing Co. v. Adams,* 151 U. S. 139, 142; *Deering v. Winona Harvester Works,* 155 U. S. 286, 289, 290; *Boyd v. Janesville Hay Tool Co.,* 158 U. S. 260, 264; *Kokomo Fence Machine Co. v. Kitselman,* 189 U. S. 8, 10, 14; *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U. S. 477, 482.

[7] Compare *McCormick v. Talcott,* 20 How. 402, 404; *Loom Company v. Higgins,* 105 U. S. 580, 586.

> difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. **But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines."**
>
> *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364, 368, 369.

The *Williams* case followed a long line of decisions in the Supreme Court of the United States, of which the Supreme Court statement in *Deering v. Winona Harvester Works*, 155 U. S. 286, 302, is a forceful statement of the law:

> "Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or **that the precise elements described in the patent as rendering it operative must be read into the claim."**

See also *Walker on Patents* (Deller's Ed.) Vol. II, § 166, p. 789, where it is stated: "A part or a combination may be claimed separately, though it cannot do useful work separately from the residue of the machine or apparatus of which it constitutes a part," and cases in point are cited. *Doble Engineering Co. v. Leeds & Northrup Co.* (CCA 1), 134 F. (2d) 78.

It is obvious that no issue of misuse should arise in this case. The Learned Courts below, relying upon the *"Mercoid,"* [1] *"Carbice,"* [2] and *"Leitch"* [3] cases, fell into

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[1] *Mercoid Corporation v. Mid-Continent Investment Co.*, 320 U. S. 661, 64 S. Ct. 268, 88 L. Ed. 376; *Mercoid Corporation v. Minneapolis-Honeywell Regulator Co.*, 320 U. S. 680, 64 S. Ct. 278, 88 L. Ed. 396.

[2] *Carbice Corporation v. American Patents Corp.*, 283 U. S. 27, 51 S. Ct. 334, 75 L. Ed. 819.

[3] *Leitch Co. v. Barber Co.*, 302 U. S. 458, 58 S. Ct. 288, 82 L. Ed. 371.

error because such cases dealt with using one element such as a switch, dry ice, etc. In none of those cases did we have the situation as in the case at bar. Here, as this Court said in the *Williams* case, *supra*, "it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail." (316 U. S. 364, 369.)

III.

NO OTHER OPPORTUNITY WILL BE AVAILABLE TO PRESENT THIS ISSUE TO THIS COURT WHICH IS OF FAR REACHING PUBLIC EFFECT CASTING DOUBT UPON THOUSANDS OF PATENTS. THE PUBLIC INTEREST REQUIRES CERTAINTY.

The far reaching public effect of the judgment of the Court of Appeals for the Third Circuit is this: It challenges the validity of a large proportion of the patents now issued, not only in mechanical fields, but in electrical and chemical fields, in which the invention lies, as this Court said in the *Williams* case, in inventing a new combination in which necessarily reference must be made in the claim to certain portions of the machine with which the new combination was to be used.

The judgment below is in conflict with this Court's established rules set forth in the foregoing cases. We believe this situation calls for the issuance of the writ in accordance with the precedent established in *Schriber-Schroth v. Cleveland Trust Company*, 305 U. S. 47, 50, certiorari granted 304 U. S. 587; *Muncie Gear Co. v. Outboard Motor Company*, 315 U. S. 759, 766; *Exhibit Supply Company v. Ace Corporation*, 315 U. S. 126, 128; *Williams v. United Shoe Machinery Corp.*, 316 U. S. 364; *Precision Instrument Mfg. Co. v. Automotive Maintenance Mach. Co.*, 324 U. S. 806; *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127.

PRAYER.

WHEREFORE, Your Petitioner respectfully prays that writ of certiorari be issued to the Circuit Court of Appeals for the Third Circuit to the end that this cause may be reviewed and determined by this Court in accordance with the principles of law heretofore announced by it; that the decree of the Circuit Court of Appeals for the Third Circuit be reversed as to the finding of invalidity of Palmer patent No. 1,603,095 dated October 12, 1926; and that the Petitioner be granted such other and further relief as may be deemed proper.

THE GALION METALLIC VAULT COMPANY,

By H. A. TOULMIN, JR.,

Attorney for Petitioner.

H. A. TOULMIN, JR.,
CLAYTON E. CRAFTS,
H. H. BROWN,
Of Counsel.

In the Supreme Court of the United States

OCTOBER TERM, A. D. 1948.

No. .....

THE GALION METALLIC VAULT COMPANY,
Petitioner,

v.

EDWARD G. BUDD MANUFACTURING COMPANY,
Respondent.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINIONS OF THE COURTS BELOW.

The memorandum of Holdings of the District Court is found on pages 3a to 9a of Petitioner's Record. The Findings of Fact and Conclusions of Law are included in the opinion. The Judgment is found on page 10a of Petitioner's Record. The opinion of the District Court is reported at 74 USPQ 90.

The opinion of the Circuit Court of Appeals for the Third Circuit (Circuit Judges Goodrich, McLaughlin and O'Connell, Judge McLaughlin writing the opinion) is reported at 78 USPQ 135 and is included in the Record.[1] (PR. 144, *et seq.*)

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[1] The opinion of the Circuit Court of Appeals for the Third Circuit, dated June 30, 1948, is included in the Record transmitted with this Petition. (PR. 144.) The Judgment of the Circuit Court of Appeals for the Third Circuit was entered on June 30, 1948, and is included in the Record transmitted with this Petition. (PR. 151.)

The Record transmitted with this Petition is the partial record designated by the parties in, and considered by, the Circuit

(Continued on following page)

JURISDICTION.

Petitioner would invoke the jurisdiction of this Court under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925, U. S. C. A. Title 28, Section 347, to review a judgment of the United States Circuit Court of Appeals for the Third Circuit, dated June 30, 1948, in a suit for infringement and validity of Palmer patent No. 1,603,095, dated October 12, 1926.

The cases believed to sustain jurisdiction are:

LeRoy et al. v. Tatham et al., 55 U. S. 156;
DeForest Radio Co. v. G. E. Co., 283 U. S. 664;
O'Reilly v. Morse, 15 How. 62;
The Telephone Cases, 126 U. S. 1;
American Fruit Growers v. Brogdex, 283 U. S. 1;
Schriber-Schroth v. Cleveland Trust, 305 U. S. 47; 304 U. S. 587;
Exhibit Supply Co. v. Ace Corp., 315 U. S. 126;
Muncie Gear Co. v. Outboard Motor Co., 315 U. S. 759;
Williams Mfg. Co. v. United Shoe Mach. Corp., 316 U. S. 364;
Precision Instrument Mfg. Co. v. Automotive Mach. Co., 324 U. S. 806;
Lincoln Engineering v. Stewart-Warner, 303 U. S. 545;
Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U. S. 127;

(Continued from preceding page)

Court of Appeals for the Third Circuit, printed in appendices to the briefs of Petitioner (Plaintiff-Appellant below) and Respondent (Defendant-Appellee below).

References to the Record are:

PR .....—Petitioner's (Plaintiff-Appellant below) Record and Opinion and Judgment of the Circuit Court of Appeals for the Third Circuit.

RR .....—Respondent's (Defendant-Appellee below) Record.

Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1.[1]

STATEMENT OF THE CASE IN PETITION.

The foregoing Petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as a statement of the questions involved in the case.

SPECIFICATION OF ERRORS.

The specification of errors herein relied upon are those reasons incorporated generally in the reasons set forth in the Petition as grounds for its allowance.

ARGUMENT.

I.

A PATENT IS VALID IF IT COVERS SUBJECT MATTER NOVEL, USEFUL, AND FALLING WITHIN ONE OF THE CATEGORIES OF PATENTABLE INVENTION SPECIFIED IN TERMS OF THE STATTE. THERE IS NO REQUIREMENT THAT IT MUST BE "PATENTABLY NEW" BECAUSE THERE IS NO SUCH SPECIFICATION IN THE STATUTE.

The Palmer patent in its single claim[2] is clear and precise. It covers a truck body designed to accommodate

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[1] In *Halliburton Oil Well Cementing Co. v. Walker*, 329 U. S. 1, notwithstanding the absence of conflicting decisions between different Circuit Courts of Appeals with respect to the patent there in suit, this Court granted a writ of certiorari to consider whether the statutory requirement (R. S. § 4888) of distinctness and certainty in claims was correctly applied by the lower court.

[2] Claim 1 of Patent No. 1,603,095 reads:

"1. In an automobile truck, the combination with a chassis frame, a load-carrying platform, means for supporting said platform above and in spaced relation to the chassis frame including a pair of longitudinal supporting members adapted to be mounted upon the chassis frame, and means forming a compartment beneath said platform for receiving pneumatic tires, said longitudinal members being cut away at their forward ends to receive the lower portion of said compartment."

a tire in such a manner as to accomplish three objectives: prevent shortening of the body by placing the tire between the front of the body and the back of the truck cab; placing the tire beneath the truck body above the chassis frame in a protected position without elevating the truck body and making it more difficult to load; and so placing the tire that it can be readily unloaded or loaded but without the disadvantage of it being in the way on the running board or exposed to the action of the elements.

This idea was new. Respondent's expert admits it. When asked whether he found anything in the prior art suggesting this idea of carrying a tire in such a position with respect to a truck body, he said: "If you limit it to a tire, the answer is, no." (PR. 137a.) Respondent infringed it. (PR. 6a.)

Neither the District Court nor the Circuit Court of Appeals could find this idea in the prior art and admitted its novelty but the Court below resorted to a new doctrine that it was not "patentably new." Therefore, this meant that the Court went outside the requirement of the statute and set up a new norm of invention, which, stated another way, is the substitution of the after-judgment of the Courts that this idea not taught by the prior art could be defeated by reconstructing various vehicles whose owners and constructors, while faced with the problem of the patentee, never saw the solution.

This is contrary to the numerous decisions of this Court such as *Topliff v. Topliff*, 145 U. S. 156; *Potts v. Creager*, 155 U. S. 597; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428; *Clough v. Barker*, 106 U. S. 166.

> "A structure which is not designed for the same purpose, where no person using it would understand that it could be put to use in the way the inventor had found, is not an anticipation. *Eames v. Andrews*, 122 U. S. 40, 7 S. Ct. 1073, 30 L. Ed. 1064; *Clough v.*

Gilbert & Barker, 106 U. S. 166, 1 S. Ct. 198, 27 L. Ed. 138; *Block v. Nathan Anklet Support Co.*, (C. C. A.) 9 F. (2d) 311."

Radio Corporation of America v. Twentieth Century Radio Corp. (CCA 2), 19 F. (2d) 290, 293.

"The structure was not designed for the same purpose as Clough's, no person looking at it or using it would understand that it was to be used in the way Clough's is used, and it is not shown to have been really used and operated in that way."

Clough v. Barker, 106 U. S. 166, 176.

When we physically reduce to practice an idea that is new and useful and patentable under our statutory classification, we have an invention. To destroy that new idea and prevent it from having protection because of the detailed phraseology of a claim such as has been done by the Circuit Court of Appeals for the Third Circuit in this case is a mere logomachy.

An invention does not lie for its protection within the skill or lack of skill or in the choice of language of the unfortunate scrivener of the patent application or his even more unfortunate client. Traditionally this Court has ignored defects in language, defects in theory of the invention, defects in the statement of the invention, and has looked with the wisdom of a Court of Chancery through the form to the substance of the invention. This we ask you to do again both under points I and II.

If this man Palmer made the public contribution that the record so clearly shows he did, it will come with bad grace to tell him that the form of his language in his effort to be clear and precise defeated his rights under the misuse doctrine and that, while his idea was new and tremendously useful and falling within the statutory category of invention, that something outside of the statute could be imported to support the retroactive judgment of the Court that the inventor, the industry, the Government of the

United States, and the Patent Office were all wrong and the Learned Circuit Court of Appeals was right in stating there was no invention after all.

While no one ever thought of it, the Circuit Court of Appeals could perceive the invention should have been thought of twenty years before when the prior inventors had the problem and failed to see it.

We respectfully submit that if this be the law, then we have no patent system. In any event, it is a question so grave as to demand the application of the wisdom of this Court in the solution of the problem.[1]

So we have a case where both the idea and the construction carrying it out were new. (PR. 6a.) What more can an inventor provide to meet this portion of the statute?[2] Both Courts and the Respondent admitted its

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[1] As recently as March 10, 1948, Judge Learned Hand cried out against this judicial method of nullifying the patent statutes. In a dissenting opinion discussing the test of invention he said:

"• • • Moreover, I am not aware of the slightest bias in favor of the present system; I should accept with equanimity a new system or no system. However, I confess myself baffled to know how to proceed, if we are at once to profess to apply the system as it is, and yet in every concrete instance we are to decide as though it did not exist as it is. In the case at bar, I can only say that, so far as I have been able to comprehend those factors which have been held to determine invention, and to which at least lip service continues to be paid, the combination in suit has every hall-mark of a valid patent."

Jungerson v. Baden (CCA 2), 166 F. (2d) 807, 812.

[2] R. S. §4886, 35 U. S. C. A. § 31, provides:

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention

(Continued on following page)

utility. (PR. 138a, 139a, 140a; 3a.) Proof was introduced of some ten thousand bodies manufactured by the Respondent, thousands more by the Petitioner, and many more thousands used by the United States Government in the last war. (PR. 60a, 138a, 139a, 140a.) Therefore, utility must be conceded.

The third test of the statute is whether the subject matter falls within a patentable classification, such as an article of manufacture. No challenge on this has been made either by the Courts or the Respondent.

We submit that this was invention—that there is no such ex-curricular test as applied by the Circuit Court of Appeals when it states that the District Court was in error when it found that Palmer's "suggestion that a spare tire be carried at the place which it indicates is new" and while conceding that "the result so obtained is evidence of invention (*Loom Co. v. Higgins*, 105 U. S. 580)," it went on to commit the error of which we complain where the Circuit Court said: "to achieve patentability it must 'not only be new but, we think, patentably new in view of the art * * *.' *Julius Levine Co. v. Automatic Paper Machinery Co.*, 3 Cir., 63 F. 2d 547, 549." (78 USPQ 135, 136, 137; PR. 146, 147.)

When we admit an invention is within the statutory classification and is new and useful, then the patent is valid. *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127.

(Continued from preceding page)

or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. R. S. § 4886; March 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212."

II.

MISUSE DOES NOT ARISE WHERE A PATENTEE OFFERS TO LICENSE AND DOES LICENSE THE GOVERNMENT AND COMPETITORS IN AN ENTIRELY PROPER MANNER JUST BECAUSE THE CLAIM STARTS IN ITS PREAMBLE WITH WORDS OF ORIENTATION SUCH AS "IN COMBINATION A TRUCK" ETC. THE STATUTE (R. S. § 4888, 35 U. S. C. A. § 33) REQUIRES SUCH PARTICULAR SPECIFICATION.[1] TO HOLD OTHERWISE IS IN CONFLICT WITH THE DECISIONS OF THIS COURT AND THE CIRCUIT COURTS OF APPEALS.

In this trade the automobile manufacturer makes the automotive vehicles such as a truck; other manufacturers, such as Petitioner and Respondent, make the bodies.

While the claims of the patent measure the invention, (*Smith v. Snow*, 294 U. S. 1, *supra*), it is necessary that everything within the four corners of the patent must be considered, **especially the title and objects of the invention.** The first thing to observe is the title of the invention which Palmer states is a "Pneumatic-Tire Carrier for Automobile Trucks." (PR. 13a.) The emphasis is on the carrier and not on the truck as a whole. The title plainly states that

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[1] R. S. § 4888, 35 U. S. C. A. § 33, provides:

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible. R. S. 4888; March 3, 1915, c. 94, § 1, 38 Stat. 958; May 23, 1930, c. 312, § 2, 46 Stat. 376."

the new pneumatic tire carrier is **merely for use in a truck.**

Page 1, lines 3 to 6, of the Palmer Patent (PR. 13a) states: "the invention has for its aim **the provision in** such trucks of means of an advantageous character for carrying one or more spare tires." This shows that the "means" represents some element **within** the truck and **not** the truck as a whole, which was the invention.

The object of Palmer's invention—page 1, lines 20 and 21—(PR. 13a) is "to provide a tire carrier"—**not** a new truck, but simply an accessory of that truck.

In attaining this object, Palmer utilizes "a space between the forward end of the loading platform and the supporting frame." (page 1, lines 23 to 25; PR. 13a.) The broad term "space" is not specified as belonging to the chassis. On the contrary, the term in the quote can refer only to the body *per se* because the chassis cannot have any "space" attribute. Even if the term "supporting frame" is read on the chassis 7, it will be noted that Palmer merely locates the defined "space" by reference to the chassis and therefore indicates that the space is located **away** from the supporting frame or chassis. Specifying the position of the "space" by reference to the supporting frame obviously cannot infer that the supporting frame is part of Palmer's invention.

Figures 1 and 2 of the patent drawings (PR. 11a) show how Palmer provides this "space." He alters the construction of the longitudinal sills 8 and makes absolutely no change whatsoever in the chassis which obviously is of old construction as Palmer states on page 1, line 43 (PR. 13a), "the truck herein shown for purposes of illustration is of usual construction." Palmer's invention does not extend below the longitudinal rails 8 and therefore could not possibly include the chassis of the truck which is located entirely below these rails.

On page 1, lines 31 and 32 of his patent (PR. 13a), Palmer states that he has illustrated a **preferred** form of the invention **"as applied" to an automobile truck.** He did not invent a new truck as a whole including a chassis, but simply improved a part of the truck, for otherwise he could not have "applied" his invention to the truck.

Page 1, lines 32 to 34 (PR. 13a), states that Figure 1 is a side elevational view of such a truck "equipped with my improved tire carrier." In other words, the truck as a whole, and apart from Palmer's invention, is old and Palmer merely applied his invention, namely, the provision of a space in the improved position for receiving spare tires, to the truck. The "truck" and the furnished "space" obviously must be entirely separate entities for otherwise one device could *not* be applied to another, and instead would have formed a part of the other. Only the body was new as can be plainly seen in Figures 1 and 2 of the patent drawings and as indicated by the title of the invention and Palmer's entire specification. (PR. 11a, 13a, 14a.)

Rule 35 of the United States Patent Office[1] requires "the specification must set forth the precise invention for which a patent is solicited * * *." (R. S. § 4888, 35 U. S. C. A. § 33.) Palmer's specification, in accordance with this Rule, draws a precise line between his tire carrier improvement, formed out of the body, and the remaining structure, including the chassis, which he does not alter in any way but simply characterizes as being "usual." As already stated, this improvement does not extend below the body of the truck and the only place that the chassis frame is mentioned in the specification is when locating the spare tire

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[1] "The specification must set forth the precise invention for which a patent is solicited, and explain the principle thereof, and the best mode in which the applicant has contemplated applying that principle, in such manner as to distinguish it from other inventions."

Rule 35, Rules of Practice, U. S. Patent Office.

space and also when noting that the rear wheels 10 are supported upon the chassis frame.

Palmer's invention as described, therefore, must relate to something less than the truck as a whole and cannot include the chassis but only the body of the truck.

Considering Claim 1 of the Palmer patent in light of the specification (*American Fruit Growers, Inc. v. Brogdex Co.*, 283 U. S. 1) and considering the claim precisely on the basis of its terminology, the claim and the specification are directed to an invention which pertains to the *body* of the truck and not to the truck as a whole.

The preamble of the claim begins "In an automobile truck." (Page 1, line 96; PR. 13a.) This shows that the truck as a whole was not improved, for otherwise the preamble would have read "An automobile truck," certainly not "In an automobile truck." Lines 1 and 2 of the claim (PR. 13a) require "the combination *with* a chassis frame." The word "with," according to *Webster's New International Dictionary* (Second Edition, Unabridged, 1946) means "together in association or time; with that; therewith." No element can be in association with another element unless it has its own identity to begin with. Thus, the phrase "the combination with a chassis frame" in the claim points out that the "combination" is different from the "chassis frame" and is merely associated therewith. This "combination" consists of all of the elements of the claim beginning with "a load-carrying platform." The chassis frame is not included and cannot be included in this combination, for otherwise it could not be associated with the combination as a separate entity as the claim requires.

The term "chassis frame" in line 5 (PR. 13a) is included only as a reference point or element from which the recited "platform" is spaced, and therefore determines the position of the platform with respect to the chassis frame. It cannot be deduced that the chassis frame is part

of the cited combination solely from the fact that it is used merely as a reference point in locating the recited platform. The third and last reference to "chassis frame" in the claim (line 102 of the patent; PR. 13a) is even more conclusive than the other two references of the same term in showing that the chassis frame is not part of the combination, nor was it intended by Palmer that it should be part of the combination.

This third reference to "chassis frame" is in connection with the clause "a pair of longitudinal supporting members *adapted to be mounted* upon the chassis frame" (line 101 of the patent; PR. 13a). According to *Webster's New International Dictionary, supra,* the word "adapt" means:

> "to make suitable; to fit, or suit; to adjust; to alter so as to fit for a new use; to render fit, by changing, to meet the demands of a new environment;—often followed by to, for, or from; as, to adapt oneself or one's conduct to circumstances; * * *."

Thus, the term "adapted to be mounted" means that Palmer's invention, as claimed, is broad enough to include not only the condition in which the longitudinal supporting members are not actually mounted upon and secured to the chassis frame but also the condition in which the longitudinal supporting members have such shape, size and relative positions as to *allow* them to be mounted on a chassis frame. The word "adapt" is used in patent claim terminology for the specific purpose of excluding any inference that the element following the adaptation clause constitutes an essential part of the combination. This is precisely what Palmer had intended from his specifications, as explained hereinbefore. Had Palmer intended the chassis frame to be an essential part of a combination, he would have revised his language to read "longitudinal supporting members mounted on and *secured to* the chassis frame."

In order to bring out this point, we trust the Court will pardon the homely but highly pertinent example of a rider and a horse. The rider is certainly "adapted" to be mounted upon the horse; yet, there is no integral connection between the rider and his horse any more than there is an integral connection between a cargo body "adapted to be mounted" and the chassis frame on which it is to be mounted.

It is highly significant that the patent neither shows nor describes any bolts between Palmer's improved body 8 and the chassis 7, thus, again indicating that the body merely rests on the chassis for explanation purposes and is an entity separate from the chassis.

Indeed, Respondent's counsel recognized the fact that only the body *per se* is covered by the patent, as on page 30 of Respondent's brief in the Circuit Court of Appeals is the statement: "As the record shows, truck bodies are furnished by body builders as separate units. In the Palmer patent the tire-carrier or receptacle is built into the body unit and the support for the box, furnished by the body longitudinals, is thus a function of importance in the patented structure."

Petitioner, therefore, submits that the Palmer Claim 1 does protect the cargo body *per se* and the claim in suit does not include the chassis frame or any part of the truck proper as an essential part of the claimed combination.

The clauses "with a chassis frame" and "adapted to be mounted on a chassis frame" in the Palmer claim are merely conditions of background for the use to which the body is to be put, and in defining the relative position of the claimed body elements and the old chassis portions of the truck (*Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U. S. 364). The chassis itself is not an element of the claim. It is not necessary to provide any element for the support of the pneumatic tires within the compartment

which is provided by the configuration of the body structure *per se* described in Palmer.

The Petitioner puts no limitation on the use of any materials or structures in connection with the use of its patented body structure. The Respondent or any other body manufacturer can build any type of body that it pleases. The only restriction sought to be imposed by Petitioner is that the Respondent shall not build a body which includes the patented compartment constructed in the particular way pointed out by Palmer. There is no attempt by Petitioner to control the sale of any unpatented materials or structures, nor to take any profit from any such.

When the proper interpretation is given to the claim, and, we submit, precisely as we have explained, the infringement is direct and there can be no misuse of the patent.

When the element of the chassis frame is eliminated from the Palmer claim as it should be, the charge of direct infringement is proven. There is no contributory infringement. There is no misuse because the infringement is direct.

In the *Temco v. Apco* case, 275 U. S. 319, involving an automobile shock absorber, the automobile manufacturers made automobiles and the plaintiff and defendant made shock absorbers to be attached to the automobiles.

In the shoe machinery field, *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U. S. 364, the United Shoe Machinery Corporation made a heel seat lasting machine and brought to it mechanisms for improved heel seat lasting which were attached to and became part of the basic heel seat lasting machine.

We do not know of any better statement of the law that applies to this case than that of the Court in the *Williams* case:

> "We think, however, that each of the claims is confined to a combination of specified means applicable only to a restricted portion and function of the whole

machine. In stating his claims, the patentee sometimes says 'a machine of the class described having, in combination, * * *' Obviously, no machine will infringe which does not have in combination the means specified in each of the claims for accomplishing the particular portion of the total operation covered by the claim. Other claims refer to 'a lasting mechanism of the class described having, in combination, * * *.' The same comment is applicable. **Other claims read: 'In a machine of the class described, the combination * * *.' Such preliminary statement is commonly and properly used to specify the type of machine in which the claimed subsidiary combination of elements works an improvement over the prior art.**[6] In describing the novel combinations embodied in the claims, it was necessary to make reference to certain portions of the machine in connection with which the new combinations were to operate and with which they were to dovetail,[7] but, in mentioning these other mechanical parts, the claim does not purport to embody them as elements of the claimed combination. **To construe such a claim for a combination of new elements intended to be embodied in some well recognized mechanical aggregation, such as a sewing machine or a washing machine, as a claim covering all the mechanical details, or all the well known parts of the machine, would be to nullify every patent for an improvement in a type of machine long in use and would invalidate thousands of patents for improvements in standard machines.** It would be difficult to describe an improvement in a washing machine without naming such a machine as the thing to which the patent is addressed, and equally

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[6] *Compare e.g. Grier v. Wilt*, 120 U. S. 412, 420, 421; *Morley Machine Co. v. Lancaster*, 129 U. S. 263, 266; *Keystone Manufacturing Co. v. Adams*, 151 U. S. 139, 142; *Deering v. Winona Harvester Works*, 155 U. S. 286, 289, 290; *Boyd v. Janesville Hay Tool Co.*, 158 U. S. 260, 264; *Kokomo Fence Machine Co. v. Kitselman*, 189 U. S. 8, 10, 14; *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 482.

[7] Compare *McCormick v. Talcott*, 20 How. 402, 404; *Loom Company v. Higgins*, 105 U. S. 580, 586.

difficult to refrain from referring to various parts of the machine, such as the tub or the motor which actuates the washer. **But it has never been thought that a claim limited to an improvement in some element of the machine is, by such reference, rendered bad as claiming a monopoly of tubs or motors used in washing machines.**"

Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U. S. 364, 368, 369.

The *Williams* case followed a long line of decisions in this Court, of which the statement in *Deering v. Winona Harvester Works*, 155 U. S. 286, 302, is an early statement of the law:

"Admitting that additional elements are necessary to render the device operative, it does not necessarily follow that the omission of these elements invalidates the claim, or **that the precise elements described in the patent as rendering it operative must be read into the claim.**"

See also: *Walker on Patents* (Deller's Ed.) Vol. II, § 166, p. 789, where it is stated: "A part or a combination may be claimed separately, though it cannot do useful work separately from the residue of the machine or apparatus of which it constitutes a part," and cases in point are cited. *Doble Engineering Co. v. Leeds & Northrup Co.* (CCA 1), 134 F. (2d) 78.

In the *Temco* case, 275 U. S. 319, *supra*, when this Court reversed the Fifth Circuit Court of Appeals and affirmed the Sixth Circuit Court of Appeals, it approved the decision in *K. W. Ignition Co. v. Temco Electric Motor Co.* (CCA 6), 283 Fed. 873, which said that the use of a reference to an automobile in a claim to which a shock absorber was to be adapted did not do more than give background to the claim, saying: "But it is only in a highly technical sense that the patent can be regarded as upon an automobile." (283 Fed. 873, 880.) This patent was sustained in the District Court by Mr. Justice Clark.

This seems to be plain common sense. Certainly the public reading a claim wants to know to what kind of an apparatus it is to be attached or with what it is to be used.

The Circuit Court of Appeals below, as well as the District Court, discarded this rule of this Court and refused to follow it, choosing to treat everything after the truck chassis as an unpatented combination like a switch or dry ice. In doing so it said that the free license by the Petitioner voluntarily given to the United States Government and the offer of a license to Respondent was misuse of the patent because an attempt to control less than the patented whole. If this be the law, then the vast majority of claims in patents now existing are invalid.

We respectfully urge upon this Court the ordering up of this case to settle this question for the public benefit. Our patent has expired and we are seeking no injunctive relief. We only have at stake a money judgment, but in the opinion of counsel we believe this decision to be of such far reaching importance that it will be a great public benefit if this Court will pass upon this new and what we believe unwarranted expansion of the doctrine of misuse which has been made by the Circuit Court of Appeals below.

III.

NO OTHER OPPORTUNITY WILL BE AVAILABLE TO PRESENT THIS ISSUE TO THIS COURT WHICH IS OF FAR REACHING PUBLIC EFFECT CASTING DOUBT UPON THOUSANDS OF PATENTS. THE PUBLIC INTEREST REQUIRES CERTAINTY.

We need add little to our statement of this point and we rest upon what we have already said.

CONCLUSION.

In conclusion, the record shows that:

1. The Courts and the Respondent's expert found the idea and construction new but the Court of Appeals added the limitation that it must be "patentably new" which is not found in the Statute.

2. The Courts found that the construction of the patent was useful and widely and successfully used commercially.

3. The Courts found that the patented subject matter fell within the classification of the Statute as an article of manufacture or a mechanical combination.

4. The Courts found that there was misuse of the monopoly by the owner of the patent because it generously, immediately upon request, gave the Government for its war purposes a free license and offered Respondent, its competitor in the making of bodies, a free license. For having done so it is penalized by the Courts below for "misuse" on the theory that the preamble of the patent mentioned a truck and therefore the Petitioner was selling something less than the complete claim. This perversion of the meaning of misuse and the policy of the Courts as to misuse by the Courts below requires rectification if we are to continue to encourage the widest possible use by way of license for the benefit of the Government and of industry from those who own patents and want to give their Government a free license and have their competitors share the cost of development on a reasonable basis.

We respectfully submit that the conclusions of the Learned Courts below require rectification by this Court and clarification of the term "misuse."

The interpretation of patent statute R. S. § 4886 on such a fundamental question is vital to our national welfare. The possession and assertion of patent rights are "issues

of great moment to the public." *Hazel-Atlas Glass Co. v. Hartford-Empire Co.*, 322 U. S. 238, 246. See also: *Mercoid Corp. v. Mid-Continent Investment Co.*, 320 U. S. 661, 665; *Morton Salt Co. v. Suppiger Co.*, 314 U. S. 488; *United States v. Masonite Corp.*, 316 U. S. 265, 278; *Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127.

A patent by its very nature is affected with a public interest; its boundaries should be precise.

We earnestly submit that this Court should order up this case.

Respectfully submitted,

H. A. Toulmin, Jr.,
Attorney for Petitioner.

H. A. Toulmin, Jr.,
Clayton E. Crafts,
H. H. Brown,
Of Counsel.

IN THE

Supreme Court of the United States

OCTOBER TERM, A. D., 1948.

No. 305.

THE GALION METALLIC VAULT COMPANY, *Petitioner,*

v.

EDWARD G. BUDD MANUFACTURING COMPANY, *Respondent.*

SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, the Galion Metallic Vault Company respectfully calls the attention of the Court to a decision by the Ninth Circuit Court of Appeals which supports our position in our Petition for Certiorari and Brief in Support Thereof and which is in conflict with the decision of the Third Circuit.

Refrigeration Engineering, Inc. v. *York Corporation,* 168 F. (2d) 896 (CCA 9), decided June 29, 1948, Petition for Certiorari to the Ninth Circuit Court of Appeals filed September 25, 1948, Docket No. 309.

The Ninth Circuit Court of Appeals said:

"Plaintiff contends that defendant's device . . . is incomplete without the element of 'a refrigerated space,' as a part thereof, and that, since plaintiff does not manufacture or sell a refrigerated space, there is no infringement 'unless an equivalent element is supplied.' While this argument is interesting, it is not persuasive. The stipulation . . . and the evidence clearly reveal that the accused device of plaintiff was designed, built and advertised *to operate within*, and in conjunction with, a refrigerated space in the same manner as the device of the defendant.

"Claim 13 contains the phrase, 'In combination with a refrigerated space,' but this does not mean that a refrigerated space is an element of the invention. Instead, it merely indicates where the invention is intended to be used. We take it that the claim might with equal propriety have read 'to operate in conjunction with' or 'in association with' a refrigerated space, or perhaps with more accuracy, 'within' a refrigerated space. That the described combination of elements performs its coil-defrosting function only when operating 'in combination with a refrigerated space' does not militate against the patentability of defendant's claim or absolve plaintiff's device of its infringing character.

"A patent claim for an oxygen-supplying combination device designed to be automatically operative only 'in, or within the stratosphere' most certainly would not entail the necessity of claiming the stratosphere itself as one of the necessary physical elements of such a device. 'Interstellar space' is not a saleable commodity, yet a device designed for the sole purpose of performing its claimed functions 'within' and only within a certain specified area of such a space would certainly possess elements of novelty and utility. To use a more mundane analogy, one whose patent claim or claims cover some new mechanical device for use *only* 'in combination with' the previously known internal combustion engine, could not claim, as such, the antecedent engine to which it necessarily must be affixed in order to function. To say that plaintiff produces a defrosting unit but does not 'sell' along with it the 'refrigerated space' within which alone it must

operate, is to announce the obvious, but this proposition has no such significance as plaintiff attaches to it.

"Neither plaintiff nor defendant makes or sells a refrigerated space in conjunction with its product. The evidence abundantly supports the conclusion that what both parties *do* manufacture and sell is a device comprised of the elements set forth in claim 13 of defendant's patent and faithfully reproduced by plaintiff. Plaintiff's argument based upon the fact that it purveys no 'refrigerated space' is ingenious but fruitless.

• • •

"At the close of all of the evidence, plaintiff moved to amend its complaint to add the following charge: 'Defendant is barred from the relief sought in the McAdam patent because it has misused the patent in an effort to control competition on unpatented devices.'

"Plaintiff offered this motion to make the pleadings conform with what it asserted to be the proof. Actually, there was no proof that defendant had misused the patent. The motion was properly denied."

168 F. (2d) 896, 900, 901.

Thus, it will be seen that the decisions of the Courts of Appeals for the Third Circuit and the Ninth Circuit are irreconcilable and in complete conflict with one another not only from the standpoint of the conclusions reached, but also from the standpoint of the premises and reasoning advanced in support of such conclusions. This Court should review the situation in order that there may be a determinative evaluation of this important phase of patent law in the interest of uniformity of decision.

We earnestly submit that this Court should order up this case.

Respectfully submitted,

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IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1948.

No. 305.

THE GALION METALLIC VAULT COMPANY,
Petitioner,

v.

EDWARD G. BUDD MANUFACTURING COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR RESPONDENT.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is reported at 74 U. S. P. Q. 90, and printed at PR., pages 3a to 9a. The opinion of the Circuit Court of Appeals is reported at 169 Fed. Rep. (2nd), 72.

STATEMENT OF THE CASE.

The case is an ordinary suit for patent infringement. Two patents were involved, and both were held invalid. Petitioner seeks review as to one patent only, to wit, the Palmer Patent No. 1,603,095, issued October 12, 1926 (expired in 1943), for Pneumatic Tire Carrier for Automobile Trucks.

The District Court held the Palmer patent invalid for lack of invention over the prior art—specifically a prior publication in Cooper's Vehicle Journal of January, 1922,

(RR. 141a), and certain mine safety trucks in use, long prior to the Palmer patent, by the U. S. Bureau of Mines and the Bureau of Mines of the State of Ohio (RR. 113a).

The Circuit Court of Appeals held the finding of invalidity for lack of invention to be without error and affirmed the judgment.

As stated in the patent (PR. 11a), "the invention relates to automobile trucks of the type which are equipped with pneumatic tires; and the invention has for its aim the provision in such trucks of means of an advantageous character for carrying one or more spare tires."

The truck, as shown in the patent, comprises the chassis with its frame 7 and the truck body with its floor or loading platform 6, longitudinal sills 8, running from the front to the rear of the truck body, and cross-sills 9. The tire carrier is simply a flat box in which one or two spare tires may be laid. To make room for the box the longitudinal sills 8 are cut away (notched out) at 12 (see Fig. 2 of the patent drawing), and the box is carried on the longitudinal sills with its lower portion fitting into the notches.

In brief, the alleged feature of novelty is the provision of a box adapted to contain one or more spare tires, the box being located beneath the forward end of the body platform and between that platform and the longitudinal body sills, the said sills being notched out at their forward ends to receive and support the box.

In Cooper's Vehicle Journal of January, 1922 (RR. 141a-143a) there is disclosed a hawker's lorry having a locker box of the same general character as Palmer's box, located at the precise point selected by Palmer, to wit, beneath the forward end of the platform and between that platform and the longitudinal body sills. Two sets of boxes are provided, and the article states that in these boxes "reserves can be readily stored as well as scales, measures and other equipment necessary for trading purposes." The required vertical clearance or space of the lockers is secured

by the use of longitudinal sills reduced in height throughout their entire length.

In the mine safety trucks (RR. 113a), space was provided beneath the forward end of the body platform and between that platform and the longitudinal body sills for carrying a number of oxygen cylinders or tanks arranged in side by side relation crosswise of the truck. The necessary vertical space or clearance for the tanks between the longitudinal sills and the platform was provided by cutting away or notching the longitudinal sills at their forward ends to receive and support the tanks at the precise location chosen by Palmer for his tire box.

As will be seen, in each of the prior structures a space or compartment was provided at the precise point selected by Palmer for his tire box, to wit, beneath the forward end of the platform and between that platform and the longitudinal body sills, and in each case the vertical space required between the platform and longitudinal sills to accommodate the article to be carried, was secured by the narrowing or notching of the longitudinal sills, thus avoiding any increase in the height of the loading platform;—Palmer's precise expedient.

In the hawker's lorry, the locker box was not large enough to receive a tire. The sole change required to permit the box to serve as a receptacle for a spare tire was to increase its width, that is to say, its dimension longitudinally of the truck, by the proper spacing of the transverse bolsters to provide the necessary space between them. At the trial, evidence was received on the fact question whether this would involve structural changes beyond the skill of the mechanic (RR. 96a-98a). It was found as a fact by the trial court, who heard the witnesses, that the making of such changes was merely a routine matter with the body builder (PR. 4a).

In view of the references mentioned, the District Court found the Palmer patent invalid for lack of patentable invention (PR. 5a).

In the Circuit Court of Appeals, that court (as clearly appears from the opinion, PR. 144) addressed itself to the question whether there was any error in the trial court's finding of lack of invention. The Court held that the record disclosed ample support for the holding, and accordingly affirmed the judgment (PR. 151).

In addition to holding the Palmer patent invalid, the District Court sustained the defense of plaintiff's misuse of the patents in suit (PR. 8a), and on this point also the Circuit Court of Appeals affirmed (PR. 149).

Neither the Petitioner nor the Respondent is a manufacturer of trucks. Each is in the body business, that is to say, each manufactures truck bodies and sells the bodies to truck manufacturers for use in the manufacture of trucks. The charge of infringement in this suit is rested upon the manufacture and sale by Respondent of truck bodies. Bodies of the same construction are made and sold by Petitioner, and it is Petitioner's attempted use of the Palmer patent in suit as a means of monopolizing that body that was found by the courts below to be a misuse of the patent.

The issue of "misuse" turned on the single question whether Palmer's Claim 1 could be applied to Respondent's truck body, *per se* (made also by Petitioner and sought to be monopolized by it), or whether to make out a case of infringement, Petitioner must resort to the completed truck, including not only the body as made by Respondent, but as well the chassis and tire carrier supplied by the truck manufacturer. Both courts below held that the Palmer patent did not purport to cover Respondent's body, *per se;* that a charge of infringement could only be based upon the combination of that body with other parts and structures not furnished by Respondent; and as the body was therefore not itself patented, Petitioner's use of the patent in attempting to monopolize the unpatented body, was a misuse of that patent under the principles of the *Carbice* case, *Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 27; *Leitch Mfg. Co. v. Barber Co.*, 302 U. S. 458; and

Mercoid Corp. v. Mid-Continent Investment Co., 320 U. S. 661.

To enable the Court to see at a glance the precise question involved in the defense of misuse, we have annexed hereto prints of Defendant's Exhibits 53, 54 and 55. Exhibit D-53 (p. 13) illustrates the body as made and sold by the Respondent; Exhibit D-54 (p. 14), the chassis and tire carrier as supplied by the truck manufacturer, and Exhibit D-55 (p. 15) the complete truck (including body, chassis and tire carrier) as completed by the truck manufacturer.

As can readily be seen from the chart Exhibit D-53, the truck body, as furnished by Respondent, contains no box, characteristic of the Palmer patent, for receiving and carrying spare tires. The longitudinal sills extend through only a portion of the length of the body, leaving a space beneath the forward end of the floor or loading platform (at the right on the chart). As shown in charts Exhibits D-54 and D-55, a tire carrier, that is to say, a bracket to which a spare wheel and tire may be secured, is mounted on the side of the chassis frame with which Respondent's cargo body is to be used; and when the body is in position on the chassis, this spare wheel and tire, supported on the bracket, can be swung up under the body platform into the space provided beneath the body platform and above the chassis frame. There is no "spare-tire carrier" in the truck body. There is a tire carrier in the assembled truck, but this is in the form of the swingable bracket mounted on the chassis.

Palmer's Claim 1 reads as follows:

"1. **In an automobile truck, the combination with a chassis frame**, a load-carrying platform, means for supporting said platform above and in spaced relation to the chassis frame including a pair of longitudinal supporting members adapted to be mounted upon the chassis frame, and **means forming a compartment beneath said platform for receiving pneumatic tires**, said

longitudinal members being cut away at their forward ends to receive the lower portion of said compartment." (Emphasis supplied.)

In seeking to apply this claim to Respondent's cargo body (Ex. D-53), Petitioner advanced the contention that the claim could be so applied by treating the introductory expression "In an automobile truck, the combination with a chassis frame, etc." as mere words of background or environment and that neither the truck nor the chassis frame was to be regarded as included in the claimed combination. It was pointed out by the Respondent that the claim not only included the chassis frame as an element but also required in the body portion of the structure "means forming a compartment * * * for receiving pneumatic tires"; that in the patent this element referred to the box built into the body to receive spare tires and serve as a tire carrier; that the space in Respondent's body beneath the front end of the floor, having no bottom, could not serve as a tire carrier, and that as the whole purpose of the Palmer patent was to provide the truck body with a tire carrier, the claim calling for this element could not be applied to Respondent's body, which lacked it.

At the trial, Petitioner, through its expert, found a bottom for the "compartment" of the claim in the tire carrier bracket mounted on the chassis frame, not made by Respondent but by the manufacturer of the completed truck (PR. 134a, 135a; RR. 9a-12a).

The District Court held (PR. 8a) that the compartment element of Palmer's claim could not be found in the Respondent's cargo body, *per se*, that is to say, without the addition of the chassis frame and tire carrier. The Court on this point said:

> "The 'compartment' element of Palmer's claim, construed broadly (as I think it should be and as it must be if it is to cover the space where the tire is carried in the defendant's body) has no bottom, and,

of course, it is necessary to have some element to support the tire in place. The patent is described as covering a 'tire carrier'; and a compartment with a top and sides but no bottom cannot possibly be a tire carrier. Thus the relationship between the patented elements of the compartment and the chassis frame is functional and goes directly to the essence of the patent. The chassis frame, specifically claimed, after reference to the entire vehicle, is plainly more than descriptive background."

The Court further held that as the claim was not limited to the body, *per se,* any infringement by the Respondent could be contributory only and that Petitioner in attempting to extend the patent to cover the unpatented body (made by itself as well as by Respondent) was plainly misusing the patent under the principles of the Carbice and other cases. On this point, the judgment was affirmed by the Circuit Court of Appeals.

ARGUMENT.

I

Petitioner's Ground I. That the Circuit Court of Appeals Departed From Principle and Resorted to a Non-Statutory Defense in Holding That a Device to Be Patentable "Must Be Patentably New."

As stated above, page 3, and as clearly appears from the opinions of the courts below, the defense sustained in the District Court and in the Circuit Court of Appeals was the defense of lack of invention. In stating that a device to be patentable must "not only be new, but, we think, patentably new in view of the art," the Circuit Court of Appeals was invoking the familiar rule that subject-matter to be patentable must not only be new and useful but must also involve invention. The phrase quoted by the Court is one used by Judge Wooley in *Julius Levine Co. v. Automatic Paper Machinery Co.*, 63 Fed. (2nd), 547, 549, where, after finding a device new, he said: "The next question is whether the combination is patentably new. The answer to that question depends on whether it involves invention, first, in view of the art, and next, whether it is a combination or an aggregation." See also *Union Paper Collar Co. v. VanDeusen*, 90 U. S. 530.

Manifestly, Petitioner's claim that there was any departure from settled principle is without foundation. On the contrary, we have a simple case of the proper application of the elementary rule that invention, as well as novelty, is required to sustain a patent—a doctrine long established by repeated decisions of this Court. *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, 90, 91.

The Palmer patent has not been involved in litigation in any other circuit, and consequently this is not a case in which a Circuit Court of Appeals has rendered a decision in conflict with another Circuit Court of Appeals on the same matter. The judgment of invalidity for lack of

patentable invention involved an ordinary fact question, in which both courts below concurred; and as the judgment was adverse to the patent, and the patent expired five years ago, no question of public interest arises; and it is submitted that Petitioner in its Ground I presents no reason for the grant of the petition.

II.

Petitioner's Ground II. That the Courts Below Erred in Sustaining the Defense of Misuse.

As pointed out above in the statement of the case (page 4), this defense turned on the question whether Claim 1 of the Palmer patent is applicable to Respondent's truck body, *per se* (made also by Petitioner and sought to be monopolized by it), as distinguished from the completed truck, including the body, the chassis and the tire carrier mounted on the chassis.

As the opinions of the District Court and the Circuit Court of Appeals clearly show, the decision that the claim could not be applied to Respondent's truck body, *per se*, was based not alone on the form of the claim as a combination claim, and the inclusion therein of the chassis frame as an element of the combination, but because without the addition of the chassis and the tire carrier (neither of which was supplied by Respondent), that element of the claim reading "means forming a compartment beneath said platform for receiving pneumatic tires" could not be found in the accused body.

It will thus be seen that the question sought to be brought up by Petitioner and argued here, to wit, whether on a question of infringment a claim framed as a combination claim, including body elements with chassis elements, could under any circumstances be construed as a claim for the body elements alone was not involved in the decision, nor was the question whether the claim could be so read when applied to the body shown and described in

the patent with its tire box or carrier built into the body. On the contrary, the question presented and decided was whether or not the claim, read in the light of the patent as a whole and of the facts in the record, could be found infringed by Respondent's cargo body, *per se,* an ordinary question of patent infringement decided adversely to Petitioner by both courts below.

Petitioner cited below, and cites here, the case of *Williams Mfg. Co. v. United Shoe Corporation,* 316 U. S. 364, as authority for the proposition that not only the introductory expression "In an automobile truck," but also the element "the chassis frame," expressly included as an element of the combination, may be treated as "environment" or background and disregarded on the question of infringement. In the *Williams* case it was held that the inclusion in a claim for an improvement of part of a machine, of parts of the old machine with which the improvement was to cooperate, did not render the claim invalid as an attempt to re-patent the original machine or its parts. The question whether such a claim could be infringed (otherwise than contributorily) by the manufacture and sale of less than the entire claimed combination, was not involved, as the case expressly shows. The attention of the Court was not directed to the specific question of infringement of a combination claim but to an entirely different question. But aside from that, the case has no bearing on the case at bar, for, as we have pointed out, in holding Claim 1 of the Palmer patent inapplicable to Respondent's cargo body, *per se,* the courts below held that without the presence of the chassis frame there could not be found in the Respondent's body the tire carrying compartment to which the whole patent was directed and that hence the chassis frame element could not be treated as mere background. (District Court, PR. 7a, 8a; Circuit Court of Appeals, PR. 149.)

The finding that the truck bodies made and sold by Respondent, and by Petitioner itself, were not covered by

the Palmer patent necessarily led to the holding of "misuse." It cannot be disputed that Petitioner (1) by notifying truck manufacturers that the purchase of the accused bodies from Petitioner carried safety under the Palmer patent, while other body builders, in view of the patent, had no right to furnish the bodies; (2) by offering licenses under the patent to body builders granting the right to make and sell bodies for use in the patented trucks upon payment of royalty on the bodies, and (3) by bringing the present suit against a competing body builder and notifying truck manufacturers that the suit had been brought, was seeking to extend the coverage of the patents to the unpatented bodies in violation of the principles made so clear by this Court in the *Carbice* case and the decisions which followed. These cases have made it very clear that the Palmer patent, with its combination claims, did not confer upon Petitioner the right to be free from competition in supplying unpatented cargo bodies to be used in making the vehicles purporting to be covered by the patent, and that a suit for contributory infringement against a competitor, in an effort to restrain such competition, cannot be maintained.

We submit that Petitioner's point II presents no sound reason for review on writ of certiorari. No question of the scope of the "misuse" doctrine, or of its proper application, was involved. The question whether the Palmer patent covered Respondent's body, *per se*, was an ordinary question of patent infringement involving the construction of the claim in the light of the patent and of the facts in the record, and, we submit, that in deciding that question adversely to the Petitioner there was no departure by the courts below from principle or authority. The Palmer patent having long since expired, no question of interest to the general public is involved in the case.

III.

Petitioner's Ground III. That No Other Opportunity Will Be Available to Present the Issues to This Court.

In support of this point, Petitioner, at page 16 of the petition, cites certain patent cases in which certiorari has been granted in the absence of a conflict between decisions of different circuit courts of appeals on the same patent. In those cases dominating patents of doubtful validity had been sustained in a circuit in which the affected industry was concentrated, so that litigation elsewhere was improbable, as in *Schriber-Roth v. Cleveland Trust Co.*, 305 U. S. 47, 50. Obviously these cases have no bearing on the case at bar, in which the patents involved have not been sustained but have been held invalid, and in which the only patent involved in Petitioner's application for writ of certiorari has long since expired.

Conclusion.

It is respectfully submitted that the petition should be denied as an ordinary patent case involving no conflict of decision between Circuit Courts of Appeals, no important question of federal law which has not been, but should be, settled by this Court, and no federal question decided in a way in conflict with applicable decisions of this Court.

Respectfully submitted,

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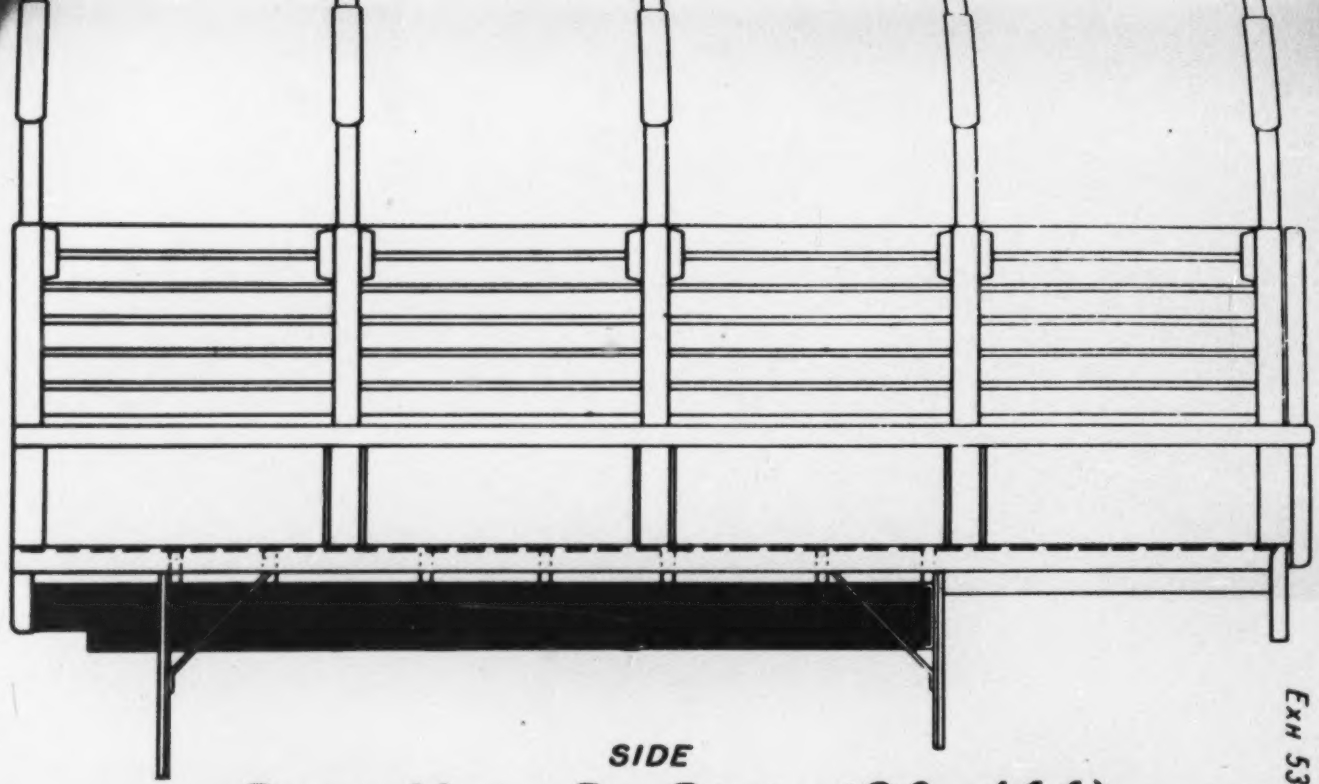

SIDE

BODY MADE BY DEF'T. (80 x 144)

EXH 53

GOVERNMENT CHASSIS

NOT MADE BY DEF'T.

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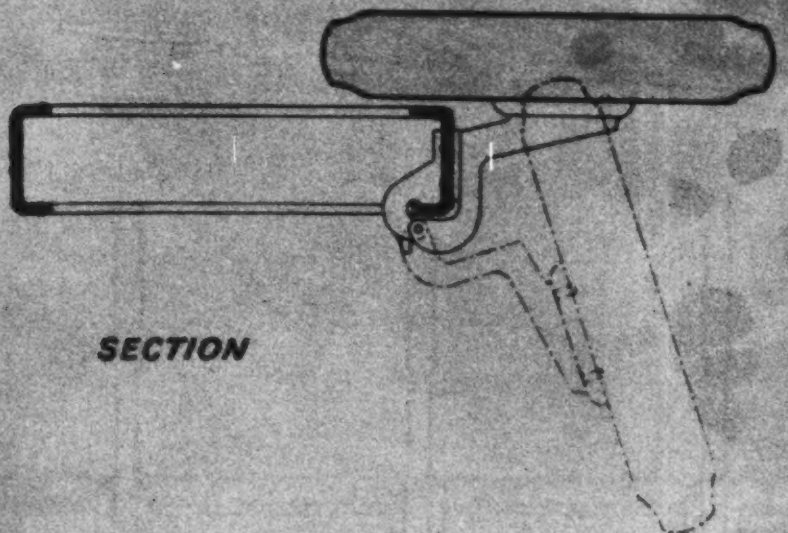

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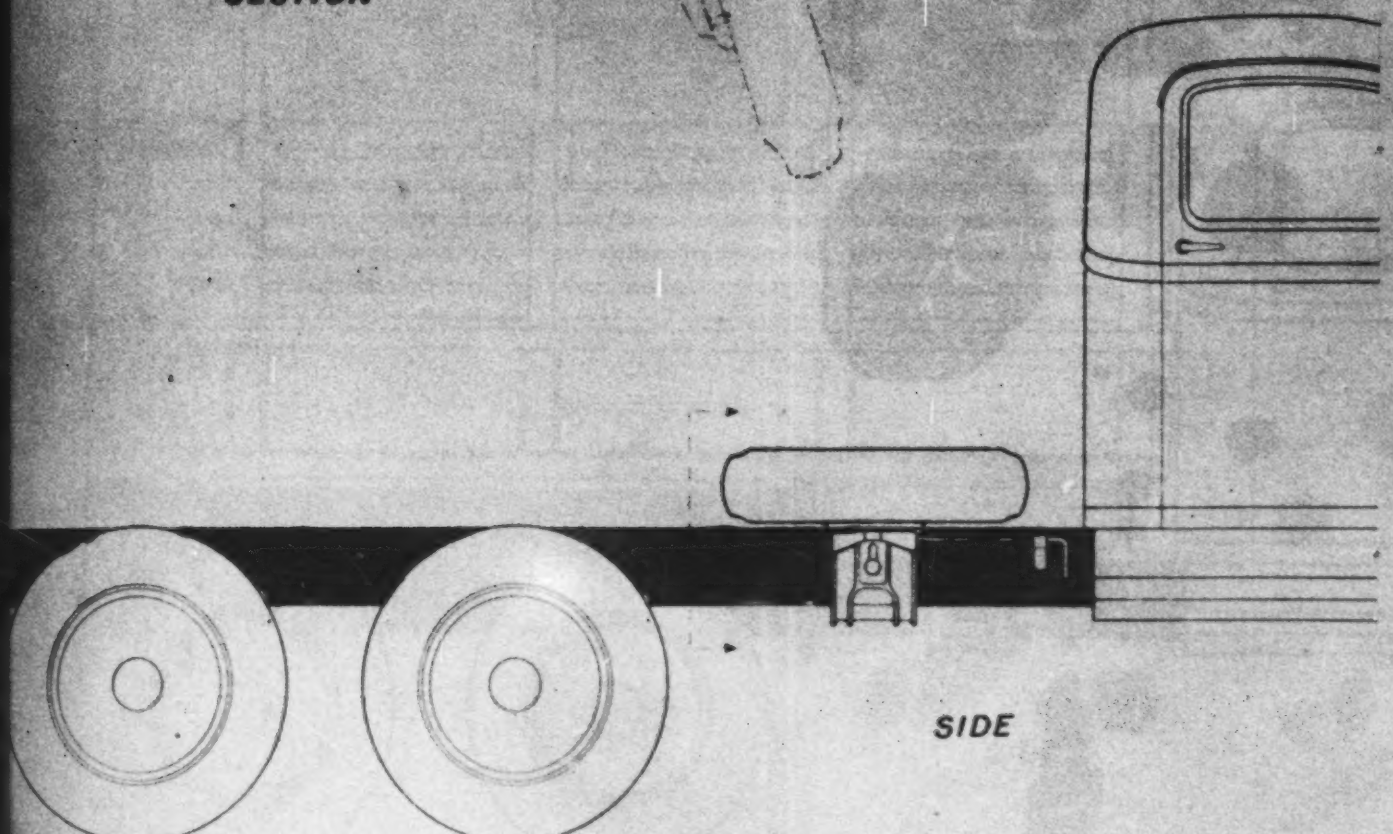

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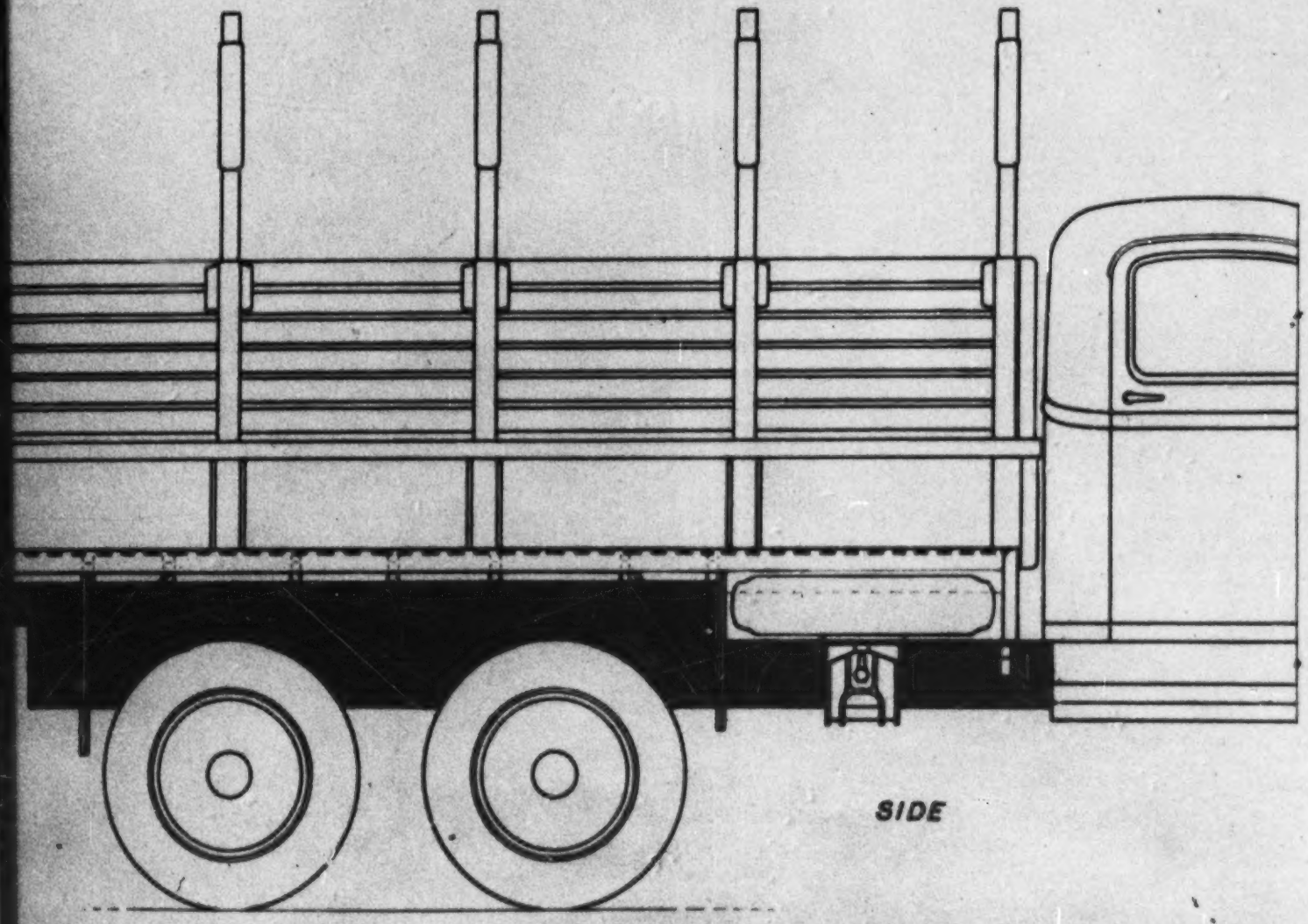

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IN THE

Supreme Court of the United States.

OCTOBER TERM, A. D. 1948.

No. 305.

THE GALION METALLIC VAULT COMPANY,
Petitioner,

v.

EDWARD G. BUDD MANUFACTURING COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

SUPPLEMENTAL BRIEF FOR RESPONDENT.

After Respondent's brief was printed, Respondent's counsel have been served with copy of an additional brief filed by Petitioner entitled "Supplemental Brief in Support of Petition."

In the supplemental brief reference is made to the case of *Refrigeration Engineering, Inc. v. York Corporation*, 168 Fed. (2nd), 896 (C. C. A. 9), and Petitioner contends that the decision of the Circuit Court of Appeals for the Ninth Circuit in that case is in conflict with the decision of the Circuit Court of Appeals for the Third Circuit in the instant case.

In the *Refrigeration Engineering, Inc.* case cited by Petitioner the Circuit Court of Appeals held that in the patent there under consideration, the introductory expression "In combination with a refrigerated space" in the patent claim did not mean that a refrigerated space was an element of the combination.

But, as we have pointed out in our main brief, the question involved in the case at bar is quite different. In the instant case, not only was the "chassis frame" specifically

recited as a part of the claimed combination, but without the inclusion of the chassis frame as an element of the claim, there could not be found in the Respondent's cargo body the "tire carrying compartment,"—also an essential element of the claim.

As pointed out in our main brief, the question whether under any circumstances—for example, the circumstances involved in the *Refrigeration Engineering, Inc.* case cited by Petitioner—an introductory expression in a claim, such as "In an automobile truck, the combination with a chassis frame," could be treated as mere background or environment, was not involved in the case at bar. On the contrary, the decision in the instant case was based not alone on the form of the claim as a combination claim, and the inclusion therein of the chassis frame as an element of the combination, but because without the addition of the chassis frame, that element of the claim reading "means forming a compartment beneath said platform for receiving pneumatic tires" could not be found in the accused body.

In the instant case, the question whether the Palmer patent covered Respondent's cargo body, *per se*, was an ordinary question of patent infringement involving the construction of the claim in the light of the patent and of the facts in the record. In the *Refrigeration Engineering* case, cited by Petitioner, the question of patent claim construction was not the same; and it is respectfully submitted that Petitioner's claim that the decisions of the courts in the two cases are in conflict is without foundation.

Respectfully,

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Of Counsel.